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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/800,767

03/08/2001

Mark A. Jones

2000-0164

3904

22907

7590

09/10/2004

BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON, DC 20001

EXAMINER

PEIKARI, BEHZAD

ART UNIT

PAPER NUMBER

2186

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,767

Applicant(s)

JONES ET AL.

Examiner

B. James Peikari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,29 and 58 is/are rejected.
7) ☒ Claim(s) 2-28,30-57 and 59-72 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 08 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because:

(a) In elements 105, 110, 205 and 210, the dark shading is improper since it reduces legibility. Note 37 CFR 1.84(m).

(b) The view numbers must be rewritten. For example, "Fig. 1" should be rewritten as "FIG. 1", etc. Note 37 CFR 1.84(u)(1).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested, "METHOD AND APPARATUS FOR USING XML FOR BOTH A PROTOCOL LAYER AND APPLICATION LAYER".

3. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. For example:

- (a) "MASP" should be defined at its first occurrence on page 2.
- (b) In the Abstract, on line 6, "." should replace ".."

Requirement for Information

4. An issue of public use or on sale activity has been raised in this application.

(a) In the Information Disclosure Statement filed on September 6, 2001, the prior art article "Using XML in the MASP Client-Server Protocol" is listed with a date of February 20, 2001.

(b) However, the date on the printed copy of the article is February 12, 2001.

(c) Furthermore, the provisional application number 60/188,992, having a filing date of March 13, 200, contains this same article with a print date of January 10, 2000.

(d) On May 2, 2000, inventor Mark Jones posted a message to a public website containing a description of "MASP" (copy attached to this Office action), including:

- (1) A description of the invention.
- (2) A statement suggesting that the invention was reduced to practice two years earlier (e.g. May 2, 1998).
- (3) A statement that MASP had already been used by "other users" for a variety of applications.

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

(a) When and where the article "Using XML in the MASP Client-Server Protocol" was first submitted for review.

(b) When and where the article "Using XML in the MASP Client-Server Protocol" was *first* published.

(c) The dates and circumstances of each public disclosure of the invention prior to March 13, 2000, including at least: to whom the invention was disclosed, whether non-disclosure agreements were signed, and what was presented in each disclosure.

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(d) Who were the "other users" and when and for what applications was the MASP used.

(e) Whether the use for "enterprise messaging applications at AT&T" or any of the other applications including "MASP client libraries and applications in Java and Perl" provided any direct or indirect commercial advantage to the assignee (e.g., faster response to clients, or the ability to complete a contracted project faster, etc.)

(f) Any preliminary versions of and XML-based transfer protocol created by the employees of the assignee or by the inventors and when and where any public disclosures of such were made.

The information is required for the examiner to determine whether an on sale or public use bar exists, or, in the alternative, whether suppression and/or concealment occurred. Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 29 and 58 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Dodrill et al., U.S. 6,490,564.

Dodrill et al. taught the independent claims in a system utilizing XML in both a document layer and an application layer. Note Figure 7.

7. Claims 2-28, 30-57 and 59-72 are objected to as being dependent upon a rejected base claim.

Conclusion

8. It is noted that if the independent claims were amended to recite that both the document layer and the application layer have an *entirely* XML-based structure, as stated in the web posting by Mark Jones (copy attached hereto), the claims would then overcome the rejection above.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Peikari whose telephone number is (703) 305-3824. The examiner is generally available between 8:00 am and 9:30 pm, EST, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached at (703) 305-3821.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 746-7239 (Official communications)

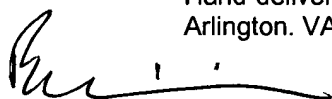
or:

(703) 746-7240 (for Informal or Draft communications)

or:

(703) 746-7238 (for After-Final communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).



B. James Peikari
Primary Examiner
Art Unit 2186

9/4/04